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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,923	09/11/2003	Peter J. Keller	1453/38768A	6001

279 7590 08/03/2004

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EXAMINER	
DINH, TAN X	

ART UNIT	PAPER NUMBER
2653	

DATE MAILED: 08/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/659,923	KELLER ET AL.	
	Examiner	Art Unit	
	TAN X. DINH	2653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☐ Claim(s) _____ is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-5 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 11/03/03; 6/01/04.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1) This application is a Continuation Application of S/N 09/641,196, filed 8/17/2000 and now is US 6,621,768; which is a Continuation Application of S/N 09/111,989, filed 7/08/1998 and now is US 6,172,948; Which claims benefit of provisional application 60/051,999, filed on 7/09/1997.

2) The I.D.S filed 11/03/2003 and 6/01/2004 have been considered by the Examiner. However, the Japan and/or foreign document(s), if they have not been written in English, are considered to the extent that could be understood from the English Abstract and the drawings.

Form PTO-1449 or PTO/SB/08 is(are) attached herein.

3) The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed Terminal Disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4) Claim *1* is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim *1* of U.S. Patent No. 6,621,768, claim *1* of U.S. Patent No 6,587,403 and claim *1* of U.S. Patent No 6,587,404. Although the conflicting claims are not identical, they are not patentably distinct from each other because all of them recited the same features with each other except that one recites a displayer and the other is not. Official Notice is taken that displayer are widely used in the art for displaying the operations of the compact disc player, for example, display the numbers of tracks, the time for each track, the total playing time, the name of the song, etc., and therefore they are old and well known. It would have been obvious to use the old and well known displayer in a compact disc recorder because, in the absence of any new or unexpected result, selecting of a known material/element based on its suitability for the intended use is deem obvious. In re LESHIN, 125 USPQ 416.

5) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6) This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7) Claims *1-5* are rejected under 35 U.S.C. 103(a) as being unpatentable over ALEXANDER et al (5,633,839) and TIMIS et al (5,792,971).

ALEXANDER et al discloses a compact disc recording system as claimed in claim 1 comprising a housing (Fig.1, housing 10), a compact disc recorder (Fig.3, CD writer 34), a data storage memory (Fig.3, 30), a display unit (Fig.1, display 12), one or more manual operable function controller in the housing (Fig.2, manual operable 18A-18K), the compact disc recording device configured such that music library is organizable into a song list and at least one group of sound tracks wherein a group of sound tracks comprises at least one sound track from the song list (Fig.2, 50), wherein compact disc recording device is configured such that one or more manually operable function controllers is useable to select a group of sound tracks to be recorded onto a

compact disc and to record group of sound tracks onto a compact disc using said compact disc recorder (Fig.3, the group of selected sound tracks 52 are recorded on CD writer 34), except to specifically show a sound receiving means. TIMIS et al from the same field teaches a sound receiving means (figure 1, Microphone 152) for receiving audio signal from outside of the CD recorder. Since the method as taught by TIMIS et al is old and well known in the art, it would have been obvious to someone within the level of skill in the art at the time of the invention was made to incorporate a sound receiving means in ALEXANDER et al's CD recorder for receiving audio signal from outside of the CD recorder as claimed.

As to claims 2 and 4, it would have been obvious to play one or group of sound tracks in CD player since the feature of selectively playing a sound track or a group of sound track from a storage memory is inherent in every CD player.

As to claim 3, ALEXANDER et al shows an amplifier (column 3, lines 58-63).

As to claim 5, the feature of adjusting output gain of audio signal is inherent in most of audio player.

8) The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (See form PTO-892 attached herein).

Applicant is reminded that in amending in response to a rejection of claims (if the rejection involves with any applicable

arts), the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objection made. Applicant must also show how the amendments avoid such references and objections. See 37 CFR §1.111(c).

9) Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAN X. DINH whose telephone number is (703) 308-4859. The examiner can normally be reached on Monday - Friday, 8:00AM - 5:30PM.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

TAN DINH
PRIMARY EXAMINER
July 27, 2004